REMARKS

I. General

Claims 1-20 are pending in the current application. Claims 1-20 are rejected in the Office Action dated August 20, 2003. No claims are currently amended. The issues raised in the Office Action are:

- Claims 1-5 and 7-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,222,934 to Tsai (hereinafter *Tsai*) in view of U.S. Patent No. 5,227,896 to Ozawa et al. (hereinafter *Ozawa*).
- Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tsai* in view of *Ozawa* and in further view of the present application specification on page 3, lines 8-21.

Applicant traverses the outstanding issues and requests, in view of the remarks set forth below, that the Examiner pass the claims to issue.

II. Rejections under 35 U.S.C. § 103(a)—Combination of *Tsai* and *Ozawa*

Claims 1-5 and 7-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tsai* in view of *Ozawa*.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the first or third criteria for establishing a prima facie case of obviousness.

A. Applied Combination Fails to Teach All Claim Elements

Independent claim 1 recites in part:

> scanning a calibration area within said look-down digital imaging device to capture image data for said calibration area (emphasis added).

Independent claim 7 recites in part:

> calibration area arranged within said look-down digital imaging device (emphasis added).

And, independent claim 15 recites in part:

> a look-down digital imaging device that includes...means for calibrating said look-down digital imaging device (emphasis added).

To make a proper 35 U.S.C. § 103(a) rejection, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. §2143. The combination of *Tsai* and *Ozawa* does not teach the limitations recited above for claims 1, 7, and 15. While *Ozawa* may teach an imaging device that is other than a flatbed digital imaging device, it mentions nothing of calibration or the desirability of calibration. Further, while *Tsai* teaches a test chart for calibration of a digital imaging device, it mentions nothing of scanning a calibration area within an imaging device. Rather, *Tsai* teaches an external test chart to be placed on the edge of a document tray when in use (Fig. 2, items 207 and 208 and Col. 3, lines 57-58). In other words, *Tsai* teaches placing a test chart on the edge of a glass platen (or "document tray") upon which originals that are to be scanned are placed. Thus, *Tsai* fails to teach or suggest including a calibration area within the imaging device.

Accordingly, the combination of *Tsai* and *Ozawa* would not result in a calibration area within the look-down imaging device of *Ozawa*. Rather, *Ozawa* does not include a glass platen (or "document tray") upon which originals to be scanned are placed, and thus such corresponding structure upon which *Tsai* teaches arranging the calibration test chart is not available in *Ozawa's* look-down imaging device. The equivalent structure in *Ozawa* is a desktop. That is, the structure upon which originals to be scanned are placed is the desktop below the look-down imaging device of *Ozawa*. Accordingly, the combination of *Tsai* with *Ozawa* would, at best, result in the placement of the calibration test chart of *Tsai* on the desktop below the look-down imaging device of *Ozawa*. Thus, the combination of *Tsai* and *Ozawa* fails to teach at least the above-identified elements of independent claims 1, 7, and 15. Therefore, Applicant respectfully asserts that independent claims 1, 7, and 15 are patentable over the combination of *Tsai* and *Ozawa*.

Further, dependent claims 2-5, 8-14, and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tsai* in view of *Ozawa*. Each of these dependent claims

depend either directly or indirectly from one of independent claims 1, 7, and 15 and thereby inherit all of the limitations of their respective independent claims. Accordingly, without conceding that the Examiner's assertions are valid with respect to the limitations of the rejected dependent claims, it is respectfully submitted that the dependent claims are allowable based on their dependency from their respective independent claims 1, 7, and 15 for the reasons discussed above. Thus, Applicant respectfully submits that dependent claims 2-5, 8-14, and 16-19 are patentable under 35 U.S.C. §103(a).

B. Lack of Motivation to Combine References

To make a proper 35 U.S.C. § 103(a) rejection there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify a reference or to combine reference teachings, and it is the Examiner's initial burden to provide some suggestion or motivation. *See* M.P.E.P § 2142. The present Office Action fails to identify proper suggestion or motivation to combine *Tsai* and *Ozawa*. The Examiner asserts on pages 2-3 of the Office Action the following:

> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine *Tsai*'s device with that of *Ozawa*, because, the combination would form a look down imaging apparatus with calibration area within the device.

This line of logic does not identify proper motivation for combining *Tsai* and *Ozawa*. Rather, this is simply a statement that it would be obvious to combine the references because such a combination can be made. It is well settled that the fact that references can be combined is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the combination because it is obvious to achieve the result. In other words, the recited motivation states that it is obvious to combine the calibration area of *Tsai* with the look down imaging apparatus of *Ozawa* because such a combination would result in a look down imaging apparatus with the calibration area. Such a statement can always be made for any combination (i.e., it is obvious to combine the references because it would result in the combination). However, this fails to identify any motivation (or desire) that would lead one of ordinary skill in the art to make such a combination.

The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01. Thus, the present Office Action fails to identify proper motivation for making the applied combination, as the motivation must establish the desirability for making the combination. Rather, it appears that the motivation is provided by the disclosure of the present application. The motivation must be provided by the prior art, not by Applicant's disclosure. Relying on Applicant's disclosure for piecing together the combination is impermissible hindsight by the Examiner. M.P.E.P. § 2143.01.

III. Rejections under 35 U.S.C. § 103(a)—Combination of *Tsai*, *Ozawa* and the present application specification

Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable *Tsai* in view of *Ozawa* and in further view of the present application specification in page 3, lines 8-21. Claims 6 and 20 depend directly or indirectly from their respective independent claims 1 and 15 and thereby inherit all of the limitations of their respective base claims. Accordingly, without conceding that the Examiner's assertions are valid with respect to the limitations of the rejected dependent claims, it is respectfully submitted that the dependent claims are allowable based on their dependency from independent claims 1 and 15 for the reasons discussed above. Thus, Applicant respectfully submits that based on at least the arguments above, claims 6 and 20 are patentable under 35 U.S.C. §103(a).

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10001227-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 256028977US in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313.

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Respectfully submitted,

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